

ESTTA Tracking number: **ESTTA731805**

Filing date: **03/07/2016**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91225825
Party	Plaintiff Castella Imports, Inc.
Correspondence Address	RALPH N. GABOURY F. Chau & Associates, LLC 130 WOODBURY ROAD WOODBURY, NY 11797 UNITED STATES mail@chauiplaw.com, gaboury@chauiplaw.com, toledano@chauiplaw.com, chau@chauiplaw.com, garramone@chauiplaw.com
Submission	Motion to Amend Pleading/Amended Pleading
Filer's Name	Ralph N. Gaboury, Esq.
Filer's e-mail	gaboury@chauiplaw.com, mail@chauiplaw.com
Signature	/Ralph Gaboury/
Date	03/07/2016
Attachments	Motion to Amend Notice of Opposition as of right A COMPANY LIKE NO OTHER ON THE PLANET 91225825 86253027 - FILED 3-7-2016.pdf(486541 bytes )

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of Application Ser. No. 86/253027  
For the mark: A COMPANY LIKE NO OTHER ON THE PLANET  
Date of Filing: April 15, 2014

CASTELLA IMPORTS, INC.,

Opposer,

v.

INTERNET PROMISE GROUP LLC,

Applicant.

Opposition No. 91225825

**MOTION TO AMEND  
NOTICE OF OPPOSITION  
AND SUPPORTING BRIEF**

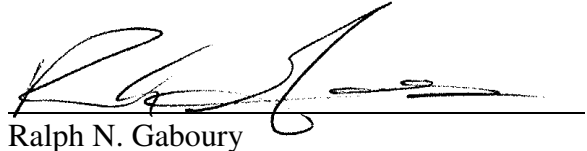
Opposer, Castella Imports, Inc. (“Castella” or “Opposer”), pursuant to Fed. R. Civ. P. 15(a)(1)(B) (“Rule 15(a)(1)(B)”), 37 C.F.R. § 2.107 and TBMP 507.02, hereby moves as of right to amend the Notice of Opposition, as set forth in the First Amended Notice of Opposition attached as Exhibit A hereto. Attached as Exhibit B hereto is a red-lined copy of the First Amended Notice of Opposition.

Opposer may amend the Notice of Opposition as of right. Applicant served its Answer on February 17, 2016, giving Opposer until March 14, 2016 (21 days plus 5 for service by mail) to serve its amended pleaded, pursuant to Rule 15(a)(1)(B). Opposer has not made any prior

amendments to the Notice of Opposition, and thus may amend “as a matter of course.” TBMP  
507.02.

Dated: March 7, 2016

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'R. Gaboury', is written over a horizontal line.

F. CHAU & ASSOCIATES, LLC


Attorneys for Opposer  
CASTELLA IMPORTS, INC.

130 Woodbury Road  
Woodbury, NY 11797  
P: (516) 692-8888  
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CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing MOTION TO AMEND NOTICE OF OPPOSITION AND SUPPORTING BRIEF has been served on Tara Chand, counsel for Applicant, by mailing said copy on March 7, 2016, via First Class Mail, postage prepaid to:

TARA CHAND  
INTERNET PROMISE GROUP LLC  
2390 CRENSHAW BLVD STE 239  
TORRANCE, CA 90501-3300

  
Ralph N. Gaboury

# EXHIBIT A

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

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CASTELLA IMPORTS, INC.,

Opposer,

v.

INTERNET PROMISE GROUP LLC,

Applicant.

Opposition No. 91225825

**FIRST AMENDED  
NOTICE OF OPPOSITION**

Castella Imports, Inc. (“Castella” or “Opposer”), a New York corporation, with an address at 60 Davids Drive, Hauppauge, NY 11788, will be damaged by registration of the mark shown in the above-identified application, and hereby opposes the same in its entirety, and offers this First Amended Notice of Opposition in support thereof.

The grounds for Opposition are as follows:

1. Since at least 2007, Castella has used the mark A COMPANY LIKE NO OTHER to brand its wholesale food distributorship services, for which it owns United States Trademark Registration No. 4538090 (the “Registered Mark”). In connection with its wholesale food distribution services, Opposer uses its Internet website to promote and offer for sale its services and various food products.

2. Castella has invested substantial monetary and other resources in the Registered Mark, which through advertising and promotion has resulted in tremendous value and recognition of the Registered Mark throughout the United States.

3. Notwithstanding Opposer's preexisting rights in and to the Registered Mark, on April 15, 2014, well after Opposer began using the Registered Mark in commerce, Applicant filed an application for registration of A COMPANY LIKE NO OTHER ON THE PLANET. The Application was assigned Serial No. 86253027, and the mark was published for opposition in the Official Gazette on September 15, 2015.

4. Applicant's mark A COMPANY LIKE NO OTHER ON THE PLANET is nearly identical to Opposer's Registered Mark, but for the addition of the words "ON THE PLANET" to the end of Applicant's mark. Given the fact that the marks at issue are nearly identical in appearance, sound and connotation, Applicant's use of A COMPANY LIKE NO OTHER ON THE PLANET is likely to cause confusion and will damage Opposer thereby. Opposer's pre-existing Registered Mark for A COMPANY LIKE NO OTHER and Applicant's mark share the first eight words, which constitute the most distinctive aspect of each mark. Further, given that Opposer uses the mark on the Internet and promotes its services using the Internet, there is a likelihood of confusion with respect to Applicant's Internet-related services, given the similarities in the visual appearance of the marks.

5. Accordingly, Applicant's use of A COMPANY LIKE NO OTHER ON THE PLANET suggests that Applicant is planning to trade off the valuable goodwill that Opposer has developed in the Registered Mark. Accordingly, Opposer will be damaged by the registration sought because consumers will be likely to believe, falsely, that Applicant's services are


authorized, sponsored or approved by Opposer or that Opposer is otherwise affiliated or connected with Applicant, in violation of Section 2(a) of the Lanham Act, 15 U.S.C. § 1052(a).

6. In addition, Applicant's registration and use of A COMPANY LIKE NO OTHER ON THE PLANET will damage Opposer because Applicant's use of this designation would be confusingly similar to Opposer's Registered Mark. As such, Applicant's use of A COMPANY LIKE NO OTHER ON THE PLANET is likely to cause confusion, deception, and/or mistake among the consuming public in violation of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

7. Opposer will be further damaged by the registration sought because such registration will support and assist Applicant in the confusing and misleading use of the mark sought to be registered, and will give color of exclusive statutory rights to Applicant in violation and derogation of the prior and superior rights of Opposer.

WHEREFORE, as Opposer will be damaged by the registration sought, Opposer respectfully requests that the Application be denied.

Dated: March 7, 2016



Ralph N. Gaboury

F. CHAU & ASSOCIATES, LLC

Attorneys for Opposer  
CASTELLA IMPORTS, INC.

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Woodbury, NY 11797  
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# EXHIBIT B

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of Application Ser. No. 86/253027  
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The grounds for Opposition are as follows:

1. Since at least 2007, Castella has used the mark A COMPANY LIKE NO OTHER to brand its wholesale food distributorship services, for which it owns United States Trademark Registration No. 4538090 (the “Registered Mark”). In connection with its wholesale food distribution services, Opposer uses its Internet website to promote and offer for sale its services and various food products.

2. Castella has invested substantial monetary and other resources in the Registered Mark, which through advertising and promotion has resulted in tremendous value and recognition of the Registered Mark throughout the United States.

3. Notwithstanding Opposer's preexisting rights in and to the Registered Mark, on April 15, 2014, well after Opposer began using the Registered Mark in commerce, Applicant filed an application for registration of A COMPANY LIKE NO OTHER ~~INON~~ THE ~~WORLDPLANET~~. The Application was assigned Serial No. 86253027, and the mark was published for opposition in the Official Gazette on September 15, 2015.

4. Applicant's mark A COMPANY LIKE NO OTHER ~~INON~~ THE ~~WORLDPLANET~~ is nearly identical to Opposer's Registered Mark, but for the addition of the words "~~INON~~ THE ~~WORLDPLANET~~" to the end of Applicant's mark. Given the fact that the marks at issue are nearly identical in appearance, sound and connotation, Applicant's use of A COMPANY LIKE NO OTHER ~~INON~~ THE ~~WORLDPLANET~~ is likely to cause confusion and will damage Opposer thereby. Opposer's pre-existing Registered Mark for A COMPANY LIKE NO OTHER and Applicant's mark share the first eight words, which constitute the most distinctive aspect of each mark. Further, given that Opposer uses the mark on the Internet and promotes its services using the Internet, there is a likelihood of confusion with respect to Applicant's Internet-related services, given the similarities in the visual appearance of the marks.

5. Accordingly, Applicant's use of A COMPANY LIKE NO OTHER ~~INON~~ THE ~~WORLDPLANET~~ suggests that Applicant is planning to trade off the valuable goodwill that Opposer has developed in the Registered Mark. Accordingly, Opposer will be damaged by the registration sought because consumers will be likely to believe, falsely, that Applicant's services

are authorized, sponsored or approved by Opposer or that Opposer is otherwise affiliated or connected with Applicant, in violation of Section 2(a) of the Lanham Act, 15 U.S.C. § 1052(a).

6. In addition, Applicant's registration and use of A COMPANY LIKE NO OTHER ~~INON~~ THE ~~WORLDPLANET~~ will damage Opposer because Applicant's use of this designation would be confusingly similar to Opposer's Registered Mark. As such, Applicant's use of A COMPANY LIKE NO OTHER ~~INON~~ THE ~~WORLDPLANET~~ is likely to cause confusion, deception, and/or mistake among the consuming public in violation of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

7. Opposer will be further damaged by the registration sought because such registration will support and assist Applicant in the confusing and misleading use of the mark sought to be registered, and will give color of exclusive statutory rights to Applicant in violation and derogation of the prior and superior rights of Opposer.

WHEREFORE, as Opposer will be damaged by the registration sought, Opposer respectfully requests that the Application be denied. ~~Submitted herewith is the filing fee to cover the fee for filing this Notice of Opposition.~~

Dated: ~~January 13~~March 7, 2016

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Ralph N. Gaboury

F. CHAU & ASSOCIATES, LLC

Attorneys for Opposer  
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